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PATENT

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DOCKET NO.: IBIS-0339**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Griffey and SwayzeSerial No.: **09/753,869**Group Art Unit: **1631**Filed: **January 3, 2001**Examiner: **M. Borin**For: **GENERATION OF VIRTUAL COMBINATORIAL LIBRARIES OF
COMPOUNDS****Certificate of Facsimile Transmission**

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office to facsimile number (703) 305-3014 on the date shown below.

On 20 June 2002
Paul K. Legaard Reg. No. 38,534Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

RESPONSE TO THE RESTRICTION REQUIREMENT

In response to the Restriction Requirement dated May 20, 2002 in connection with the above-identified patent application, Applicants elect Group II, containing claims 12 and 13 **with traverse**.

The Examiner has mistakenly restricted claims 1-26 into three (3) groups. Group I contains claims 1-11 drawn to methods of generating a virtual library *in silico*. Group II contains claims 12 and 13 drawn to methods of identifying compounds. Group III contains claims 14-26 drawn to methods of storing information.

The Office Action mistakenly asserts that Groups I-III are "related as independent and/or patentably distinct methods." The Office Action also asserts that the methods have different effects and different steps. Even if the Examiner considers the groups of claims to be patentably distinct,

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however, § 803 of the M.P.E.P. mandates two criteria for a proper requirement for restriction: 1) the inventions must be independent or distinct; and 2) there must be a serious burden on the examiner. For purposes of initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. § 808.02. Significantly, the Examiner has not met the *prima facie* burden -- no such explanations have been provided. Indeed, the Examiner has not shown separate status in the art or a requirement for a different field of search. Further, each of the groups of claims has, in fact, been classified into the same class (class 707), thus, strongly indicating a lack of serious burden. Accordingly, *all pending claims* should be examined in the present application without restriction. At a minimum, Groups I and II should be combined into a single group.

Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. § 121. In addition, Applicants submit that, at a minimum, claims 1-13 must be considered in the present application without restriction.

Respectfully submitted,



Paul K. Legaard
Registration No. 38,534

Date: 20 June 2002

WOODCOCK WASHBURN LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439